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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,634	08/28/2003	David W. Old	17609 (AP)	1835
7590	05/17/2005		EXAMINER	
Robert J. Baran ALLERGAN, INC. Legal Department 2525 Dupont Drive Irvine, CA 92612			SHIAO, REI TSANG	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/652,634	OLD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Robert Shiao	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on responses filed on 03/17, 2005.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-34 is/are pending in the application.  
4a) Of the above claim(s) 1-13, 16-20 and 23-30 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 14, 15, 21, 22 and 31-34 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 28 August 2003 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08/28/03, 1/18/2005.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Amendment of claims 14, 21-22, addition of claims 31-34 in the amendment filed on March 14, 2005, is acknowledged. Claims 1-34 are pending in the application. Since the newly added claims 31-34 are commensurate with the scope of the invention, therefore, claims 1-34 are prosecuted in the case.

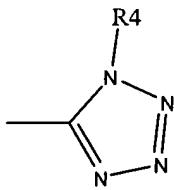
#### ***Responses to Election/Restriction***

2. Applicant's election with traverse without argument of Group IV claims 14-15 and 21-22, in part, in the reply filed on March 17, 2005, is acknowledged.

#### ***Status of the Claims***

3. Claims 1-34 are pending in the application. The scope of the invention of the elected subject matter is as follows:

Claims 14-15, and 21-22, in part, drawn to compounds/compositions of formula (I), wherein the variable Z represents alkyl, cycloalkyl, aromatic radical, or heterocyclic aromatic radical chlorobenzothiophenyl or benzothiophenyl thereof;



the variable R does not represents R4-C1=C2=C(N=C2N)N1, variables W, Y, R<sup>1</sup>, R<sup>2</sup>, and R<sup>3</sup> are as defined in claim 1. Since the newly added claims 31-34 are commensurate with the elected subject matter, therefore, claims 31-34 are prosecuted along with claims 14-15 and 21-22. Claims 14-15, 21-22, and 31-34 in part, embraced in above elected subject matter, are prosecuted in the case. Claims 14-15, 21-22, and 31-34, in part, not

embraced in above elected subject matter, and claims 1-13,16-20, and 23-30, are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper and is therefore made **FINAL**.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

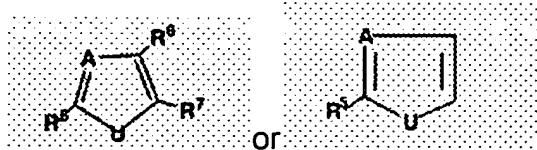
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14-15,21-22, and 31-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14 and 21, i.e., claim 14, lines 9-10, recites limitation "R<sup>4</sup>" without limitation, is ambiguous and indefinite. Incorporation of the limitation of "R<sup>4</sup>" of formula (I) into the claims would obviate the rejection, see page 6, lines 4-7.

***Objection***

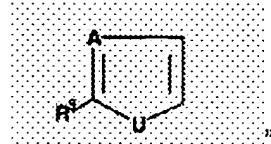
5. Claims 14-15,21-22, and 31-34 are objected to as containing non-elected subject matter, i.e., heterocyclic or heteroaryl of variable Z, formula



of claims 31 and 33, etc. It is suggested

that applicants amend the claims to the scope of the elected subject matter as defined on the pages 2-3 *supra*.

6. Claim 31 is objected. It appears there are typographic errors of the phrase "Z is



wherein U is selected from" and "R<sup>6</sup> and R<sup>7</sup> are selected from ", see claim 31, page 4, lines 1-4, and page 5, lines 3-8. Correction is required.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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May 06, 2005